APPENDIX A

Statutes Involved

17 U.S.C. Sections 1(a), 1(b), 3 and 4 as amended

§ 1. Exclusive rights as to copyrighted works

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;

(b) To translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art; * * *

* * * * *

§ 3. Protection of component parts of work copyrighted; composite works or periodicals

The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title.

* * * * *

§ 4. All writings of author included

The works for which copyright may be secured under this title shall include all the writings of an author.

APPENDIX B

Opinion of the United States Court of Appeals, For the Ninth Circuit

CAPTION

No. 13,457.
Nov. 9, 1954.

APPEAL FROM THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
CENTRAL DIVISION

Before: STEPHENS and FEE, Circuit Judges, and CLARK, District Judge

STEPHENS, Circuit Judge

Dashiell Hammett composed a mystery-detective story entitled *"The Maltese Falcon"* which was published serially, and each installment was copyrighted by the publisher. Subsequently, Alfred A. Knopf, Inc., entered into a contract with the author to publish the work in book form. Knopf published the book and, in accord with the terms of the contract, copyrighted it.

In 1930, after publication in book form and after publication of all installments of the first serial thereof, Knopf and Hammett, designated as "Owners", for a consideration of $8,500.00, granted certain defined rights in and to The Maltese Falcon (called "writings" in the agreement) to Warner Bros., as "Purchaser".[1] Coin-

[1] The Hammett-Knopf-Warner contract, with certain formalities deleted as in the district court's memorandum decision of December 28, 1951, 102 F. Supp. 141, 143, is as follows:

"* * * Warner as 'Purchaser' was granted the following rights inter alia 'in and to that certain story, hereinafter called "writings",

cidentally, Knopf executed an instrument to Warner called "Assignment of Copyright" [2] for a nominal consideration.

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entitled "Maltese Falcon" * * *: 1. (a) the exclusive * * * motion picture rights including, common law and statutory copyright in the same * * * together with all benefits of the copyrights in such writings, the title and the theme thereof, and of all remedies held thereunder, with respect to such motion picture rights; (b) the exclusive right to make motion picture versions thereof * * * including the exclusive right to show * * * photographs in motion, representing scenes or action taken from or based upon said writings, or any adaptation thereof; (c) the exclusive right to record and reproduce language, speech, songs, music, dancing, choreography and other sounds in connection with * * * the production and exhibition of photoplays based upon such writings * * *; (d) the exclusive right for the purpose of such sound records and photoplays, to adapt, use, dramatize, arrange, change, transpose, make musical versions of, add to, interpolate in and subtract from said writings, the language, title and dialogue thereof * * *; (e) the exclusive right to record such writings, language and dialogue and such adaptations, dramatizations, arrangements, change * * * and interpolations on sound records and to reproduce the same from such sound records in synchromism with and/or separately from such photoplays * * *; (f) the right in the writings for production and use upon the spoken stage * * * is reserved to the Owners, but all other now or hereafter existing dramatic, exhibition or other presentation rights in the writings, and without limiting the generality of the foregoing, including talking motion picture rights * * * as well as the right to transmit and exploit scenes and pictures taken or adapted from or based upon said writings, the language, title and dialogue thereof, by radio, television or otherwise, together with the right to transmit and reproduce by radio, television or otherwise, the writings, the language, title and dialogue thereof and the sound records herein referred to in connection with the broadcastings of said motion picture versions * * * are granted exclusively to the Purchaser * * * [and] 12. The Owners warrant and agree that they will not cause or allow or sanction any publication or dramatization of said writings or any arrangement, or version or reissue thereof in any form in any parts of the world, without first granting to the Purchaser, without further consideration, the silent and talking motion picture rights and the mechanical and recording and reproducing rights (and all the rights set forth in paragraph (1) hereof) and in and to any such arrangement, revision or reissue above named.' "

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[2] "ASSIGNMENT OF COPYRIGHT. Whereas, Dashiell Hammett is the author of a certain literary composition entitled "Maltese Falcon", five

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The text of the "assignment" shows on its face that it is not an assignment of the copyright but that it is a grant to Warner of specified rights to the use of the writings in The Maltese Falcon. Both the contract between Hammett-Knopf and Warner, and the "assignment" from Knopf, purport to grant to Warner certain defined and

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installments of which have been published * * * and have been copyrighted by Pro-Distributors Corporation; and

"Whereas, the Pro-Distributors Corporation has heretofore assigned to the Undersigned, Alfred A. Knopf, Inc., the foregoing copyrights, and

"Whereas, the Undersigned published a novel, "Maltese Falcon" in book form, and registered the novel in United States Copyright Office * * *,

"Now, Therefore, in consideration of the sum of One Dollar in hand paid and for other valuable considerations now received, the Undersigned sells and assigns unto Warner Bros. Pictures, Inc., its successors and assigns forever, the motion picture and talking motion picture rights * * * in and to the said literary composition (hereinafter called 'writings') and all motion picture rights in all copyrights thereof, as well as radio broadcasting and television rights, * * * together with the sole and exclusive right to use, interpolate songs, music, sounds, words and dialogue in, translate, adapt and change said writings and the title in the making of or in conjunction with or separately and apart from motion picture photoplays, and to lease, vend and exhibit the same throughout the world, and to copyright the same in its own name or otherwise, including the right to record and reproduce sounds, language, dialogue and speech taken, adapted and translated from the writings, in connection with and/or in synchronism with and/or separately from the production and exhibition of photoplays based upon such writings, whether such records be on the film itself or on separate discs, or any other material or medium, by means of mechanical, electrical, photographic or other devices and improvements thereupon which are now or hereafter may be used in connection with the production and exhibition of motion pictures (hereinafter referred to as 'sound records') and to copyright in its own name or otherwise said sound records.

"The Undersigned agrees to obtain or cause to be obtained a renewal of such copyrights according to law in order to secure said rights in Warner Bros. Pictures, Inc., during any and all renewal terms, and the Undersigned hereby appoints Warner Bros. Pictures, Inc., its attorney-in-fact with an irrevocable power to do all acts and things for and in the name of the Undersigned to obtain such renewals.

"Dated: June 23, 1930."

detailed exclusive rights to the use of The Maltese Falcon "writings" in moving pictures, radio, and television.

By the common law, the author of a writing possesses the sole and exclusive right to publish it, but upon and after the first publication the writing may be published by anyone including the author, since the writing has gone into the public domain. *Bobbs Merrill Co. v. Straus,* 1908, 210 U.S. 339; *Bobbs Merrill Co. v. Straus,* 1908, 147 F. 491; *Harper Bros. v. M. A. Donohue & Co.,* 1905, 144 F. 491. The copyright statute extends the author's sole and exclusive right in accordance with its terms and provisions. *Constitution of the United States,* Art. I, Sec. 8, Clause 8; Title 17 U.S.C.A.; *Bobbs Merrill Co. v. Straus,* 1908, 210 U.S. 339; *Bobbs Merrill Co. v. Straus,* 1908, 147 F. 15. In other words, it reserves the writing from the public domain for the effective period of the copyright. What we have just said is what is meant by courts when they say: "When the copyright comes in, the common law right goes out."

No question as to the legality of the copyright on The Maltese Falcon or to its continuing effectiveness through all times in suit, or to its complete beneficial ownership by Hammett and Knopf together, is in issue. Therefore, at the effective moment of the grants by Hammett and Knopf to Warner, the latter became possessed of the sole and exclusive right to the writing which is within the copyright, less all limiting terms of the grants. The grants are limited to defined uses in motion picture, talking pictures, radio, and television.

It is claimed by Warner that it acquired the exclusive right to the use of the writing The Maltese Falcon, including the individual characters and their names, together with the title, "The Maltese Falcon", in motion

pictures, radio, and television. The use of the title is not in issue, since the grant to Warner specifically includes it.

It is the position of Hammett and the other defendants, all of whom claim some interest under him, that the rights acquired by Warner are those specifically mentioned in the conveying or granting instruments, and that the exclusive right to the use of the characters and/or their names were not mentioned as being granted; that the instruments, properly construed, do not convey any exclusive right to the use of characters with or without names, hence Hammett could use them in other stories. However, if, by reason of the silence in the instruments as to such claimed rights, the instruments should be held to be ambiguous on this point, the custom and practice demonstrate that such rights are not customarily parted with by authors, but that characters which are depicted in one detective story together with their names are customarily retained and used in the intricacies of subsequent but different tales.

Hammett did so use the characters with their names and did contract with others for such use. In 1946 he used The Maltese Falcon characters including Sam Spade, the detective and the leading character in the Falcon, by name, and granted to third parties the sole and exclusive right, except their use in the Falcon, to use that character by name (later orally enlarged to include other characters of the Falcon) in radio, television, and motion pictures. Under such claimed rights, radio broadcasts of "Adventures of Sam Spade", including "The Kandy Tooth" were broadcast in weekly half-hour episodes from 1946 to 1950.

Warner claims infringement of copyright and "unfair use and "competition" by such re-use and, as well, for

infringement of parts of the story and the whole of the writing inclusive of characters and their names. Hammett and the other defendants deny infringement or unfair use and competition on any count, and Hammett requests the court to declare his rights in the premises. Knopf is a nominal party asking and claiming nothing, and is made a plaintiff under the right granted Warner in the Hammett-Knopf-Warner contract.

The trial court denied relief to Warner, declared Hammett's rights, and assessed costs against Warner, who appeals.

The instruments under which Warner claims were prepared by Warner Bros. Corporation which is a large, experienced moving picture producer. It would seem proper, therefore, to construe the instruments under the assumption that the claimant knew what it wanted and that in defining the items in the instruments which it desired and intended to take, it included all of the items it was contracting to take.[3] We are of the opinion that since the use of characters and character names are nowhere specifically mentioned in the agreements, but that other items, including the title, "The Maltese Falcon", and their use are specifically mentioned as being granted, that the character rights with the names cannot be held to be within the grants, and that under the doctrine of *ejusdem generis,* general language cannot be held to include them.[4] As was said in *Phillip v. Jerome H.*

[3] Taylor v. U. S. Casualty Co., 269 N.Y. 360, 199 N.E. 620; Evelyn Building Corp. v. City of New York, 257 N.Y. 501, 178 N.E. 771; Tobani v. Carl Fischer Inc., 1942, 33 NYS.2d 294, 299; Hunt v. United Bank & Trust, 1930, 210 Cal. 108, 116, 281 P. 184.

[4] Bouvier's Law Dictionary, Baldwins Students Ed., 1934, p. 336; 3 Williston on Contracts, Rev.ed., 1784. See, also, Smith v. McCullough, 1881, 104 U.S. 25, 28; Swift & Co. v. Columbia Ry. Gas & Electric Co., 1927, 17 F.2d 46, 48; Cleveland Trust Co. v. Consolidated Gas etc. Co., 1932, 55 F.2d 211, 215.

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Remick & Co., S.D., N.Y., Op. No. 9,999, 1936, "Such doubt as there is should be resolved in favor of the composer. The clearest language is necessary to divest the author of the fruits of his labor. Such language is lacking here." See, also, *Tobani v. Carl-Fischer, Inc.*, 1942, 263 App. Div. 503, 507, 33 NYS2d 294, 299, affirmed 1942, 289 N.Y. 727.

The conclusion that these rights are not within the granting instruments is strongly buttressed by the fact that historically and presently detective fiction writers have and do carry the leading characters with their names and individualisms from one story into succeeding stories. This was the practice of Edgar Allen Poe, Sir Arthur Conan Doyle, and others; and in the last two decades of S. S. Van Dine, Earle Stanley Gardner, and others. The reader's interest thereby snowballs as new "capers" of the familiar characters are related in succeeding tales. If the intention of the contracting parties had been to avoid this practice which was a very valuable one to the author, it is hardly reasonable that it would be left to a general clause following the specific grants. Another buttressing fact is that Hammett wrote and caused to be published in 1932, long after the Falcon agreements, three stories in which some of the leading characters of the Falcon were featured, and no objection was voiced by Warner. It is also of some note that the evidence shows that Columbia, long subsequent to the conveying instruments, dickered with Warner for the use of the Falcon on its "Suspense" radio program and, failing in its efforts, substituted "The Kandy Tooth" which uses the Falcon characters under license of Hammett. Warner made no claim against Columbia at or reasonably soon afterward. The conclusion we have come to, as to the intention of the parties, would

seem to be in harmony with the fact that the purchase price paid by Warner was $8,500.00, which would seem inadequate compensation for the complete surrender of the characters made famous by the popular reception of the book, The Maltese Falcon; and that the intention of the parties, inclusive of the "Assignment", was not that Hammett should be deprived of using the Falcon characters in subsequently written stories, and that the contract, properly construed, does not deprive Hammett of their use.

Up to this point we have discussed the points at issue by construing the contract and by seeking the intention of the parties to it, and we have concluded that the parties never intended by their contract to buy and sell the future use of the personalities in the writing.

It will now be profitable to consider whether it was ever intended by the copyright statute that characters with their names should be under its protection.

The practice of writers to compose sequels to stories is old, and the copyright statute, though amended several times, has never specifically mentioned the point. It does not appear that it has ever been adjudicated, although it is mentioned in *Nichols v. Universal Pictures Corp.*, 1930, 45 F.2d 119. If Congress had intended that the sale of the right to publish a copyrighted story would foreclose the author's use of its characters in subsequent works for the life of the copyright, it would seem Congress would have made specific provision therefor. Authors work for the love of their art no more than other professional people work in other lines of work for the love of it. There is the financial motive as well. The characters of an author's imagination and the art of his descriptive talent, like a painter's or like a person with his penman-

ship, are always limited and always fall into limited patterns.[5] The restriction argued for is unreasonable, and would effect the very opposite of the statute's purpose which is to encourage the production of the arts.

It is our conception of the area covered by the copyright statute that when a study of the two writings is made and it is plain from the study that one of them is not in fact the creation of the putative author, but instead has been copied in substantial part exactly or in transparent rephrasing to produce essentially the story of the other writing, it infringes.

It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright. The subject is given consideration in the *Nichols* case, supra, at page 121 of the citation. At page 122 of the same case the court remarks that the line between infringement and non-infringement is indefinite and may seem arbitrary when drawn; nevertheless it must be drawn. *Nichols v. Universal Pictures Corp.*, 1930, 45 F.2d 119. See *Warner Bros. Pictures v. Majestic Pictures Corp.*, 70 F.2d 310, 311.

We conclude that even if the Owners assigned their complete rights in the copyright to the Falcon, such as-

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[5] "He must be a poor creature that does not often repeat himself. Imagine the author of the excellent piece of advice, 'Know thyself', never alluding to that sentiment again during the course of a protracted existence! Why, the truths a man carries about with him are his tools; and do you think a carpenter is bound to use the same plane but once to smooth a knotty board with, or to hang up his hammer after it has driven its first nail? I shall never repeat a conversation, but an idea, often. I shall use the same types when I like, but not commonly the same stereotypes. A thought is often original, though you have uttered it a hundred times. It has come to you over a new route, by a new and express train of associations." The Autocrat of the Breakfast Table, by O. W. Holmes, M.D., p. 9, reprint of original edition.

signment did not prevent the author from using the characters used therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story.

We turn to the consideration of general infringement. It is agreed that a story entitled "The Kandy Tooth" is the closest to The Maltese Falcon, and from a practical standpoint if the Tooth does not infringe the Falcon, there has been no infringement.

We have set out in notes 7 and 8 at the end of this opinion, short summations of the two works. There is a sameness in the tricks of spinning out the yarn so as to sustain the reader's suspense a to hinted mystery, and there is a similarity in the two stories in that there is a long complicated search for a lost article of fabulous value. The searches are filled with complications, fatalities, and moral delinquencies by characters in name, description, and action of some similarities. The script of the Tooth was not composed by Hammett and, except for a few expressions, is not written in the Hammett literary style.

We see no clear error in the trial court's holding that the similarities of the two stories do not go to the degree of constituting practically the same story. There is no textual copying; the mystery of the Tooth and the suspense to the reader would not be dulled through his having read the Falcon. In a phrase, they are different stories though of the same general nature.

Unfair Use and Competition

Warner claims the radio broadcasts, "The Adventures of Sam Spade" and the "Suspense" broadcast of "The Kandy Tooth", and others, wherein the characters of the Falcon were used by name and their peculiarities, con-

stituted unfair use and competition. The trial court found against such contention and we think the conclusion does not constitute clear error.

It is patent that the characters of The Maltese Falcon could not fairly be used in such a manner as to cause the Falcon to be materially lessened in its commercial worth by degrading or cheapening them so that the public would not be interested in their capers.[6] They could not be used in such a manner as to deceive the public or to "palm off" to the public the idea that they were really witnessing The Maltese Falcon when they viewed showings of the other stories.[7] We think there was no reversible error in the court's conclusions on these points.

Although we have thought it necessary to arrive at some conclusions not entirely in accord with those of the district court, or to arrive at like conclusions through somewhat different reasoning, nevertheless we commend a reading of that court's opinion and notation of authorities cited. We are in complete accord with the order of the district court that the plaintiffs-appellants take nothing, and that defendants-appellees recover their costs.

The judgment in accordance with this opinion will settle all of the issues of the case, including all of Hammett's interest in the subject matter under Warner's claims. There is no justiciable controversy between Hammett and Knopf, the nominal plaintiff. It follows that no useful purpose could be served by considering Hammett's prayer for a declaration of his rights and his counterclaim for a declaratory judgment is therefore dismissed and the judg-

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[6] Manners v. Morosco, 1919, 252 U.S. 347; Harper Bros. v. Klaw, 1916, 232 F. 609.

[7] Stork Restaurant v. Sahati, 9 Cir., 166 F.2d 348; Lone Ranger v Cox, 4 Cir., 124 F.2d 650.

ment running to him on it is reversed. Otherwise, the judgment is affirmed.[8] [and] [9]

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[8] THE MALTESE FALCON STORY. The theme of the story of The Maltese Falcon is a complicated search for a fabulously valuable bird figurine called The Maltese Falcon. The action of the story centers in San Francisco from elsewhere, with the leading actors or characters gathering there intent upon the objective. An attractive, alluring woman of uncertain age and reputation, by name Brigid O'Shaughnessy, assuming a false name and great distress, in search of help, called upon private detective Sam Spade, a clever, laconic, rangy-looking man whose morals and practices are none too idyllic, and well if not too favorably known to the police. Brigid qualifies within the requisite of the proverbial monumental liar, but, though Spade is not deceived, she manages to withhold the truth from him. A dunderhead policeman and his partner enter the tangled story. Effie Perine is Spade's secretary, one of those see-all know-all, self effacing paragons of loyal efficiency. A mystical character of a man who apparently is cooperating with Brigid against three others of their search-party gets shot to death and Spade is under suspicion. The leader of the search-party is a fat man named Gutman, of infinite patience and possessed of untold money. He proposes to pay a large sum to Sam who represents that he can deliver the bird. An effeminate lackey of a man by the name of Cairo does Gutman's bidding. A young, boyish gunman is under Gutman's orders. The story runs on at accelerated tempo in mystery until the captain of a ship, just in from the Orient, appears at Spade's apartment with a package in hand and falls dead from the boy's bullets sent into him just before he entered Spade's place. All gather at Sam's for the delivery of the bird, supposed to be in the package, and for payment of the money. Sam gets the award and Gutman gets the bird, which is a worthless counterfeit of the genuine. Gutman maintains his sang-froid. Brigid and Sam have trespassed the conventions. Yet, as somehow it is revealed the lady herself was the author of the first fatality, she is delivered over by the benevolent Sam and is sent on her way to San Quentin prison. These characters are skillfully depicted in a running, attractive style and distinctly assume individualism as distinguished from mere other persons.

Warner claims ownership of all of this including the characterizations with the characters' names, and the story.

[9] THE KANDY TOOTH STORY. The script opens with Sam Spade telephoning from jail to his faithful secretary, Effie Perine, early in the morning. Effie hurries to Sam who dictates his story. Dundy, the police officer, is present. Spade has received a telegram from the fat Caspar Gutman who had been marked "dead" from the end of The Maltese Falcon caper. The telegram is a warning about "an invidious

Appendix B

Reversed and Affirmed in part.

(Endorsed:) Opinion. Filed Nov. 9, 1954.

Paul P. O'Brien, Clerk.

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pair of rogues", a dentist, and a charming woman named Hope Laverne, who have something to do with a "hidden tooth". Spade is bailed out by a mystery man who deposits $20,000.00 with the law. Gutman will shortly arrive in San Francisco. The dentist, so Spade dictated, had been ushered into his office by Effie and entreats him to get someone's "bridge". The dentist leaves. Spade contemplates "Hm-m-m * * * Beware the Hidden Tooth". In comes Hope Laverne, a character along the line of Brigid O'Shaughnessy, and she is, or claims to be, a sister of the dentist. Hope explains the brother's obsession about a dental bridge. She wants to find him. Spade goes to a hotel, gets information from a house detective, and finds the brother, badly beaten; the two walk on the street—the dentist collapses. Spade takes him into a newsreel theater. The show excites him—it's about white elephants and particularly Oriental in character. Spade and the dentist go back to Spade's room. There Laverne recites a story of a tooth having been extracted from the jaw of a sacred body long since the occupant of an Oriental tomb. The tooth was taken by international rogues and installed by the dentist in a bridgework of an innocent refugee. The rogues are now attempting to locate the refugee and regain the priceless tooth.

Hope calls Spade on the telephone for help, and he goes, but is attacked by a boy, brother of the gun-boy in The Maltese Falcon. They scuffle and Spade is felled by a gun butt. He comes to in the presence of the imperturbable Gutman and strange happenings ensue. Spade finally gets the tooth in the ashes of the cremated body of the refugee, Herman Julius. $20,000.00 is paid upon delivery of the package containing the ashes. The tooth, by reason of a religious significance, is worth untold wealth to Gutman if he can produce it. A murder is committed; Hope and Sam had been more than friends. A Russian was mixed up in the plot. When Gutman saw that he had been duped through the delivery to him of the cremation residue, he took it as philosophically as when the bird in The Maltese Falcon turned out to be spurious. It developes that $20,000.00 had been put up for Sam's bail, and Sam puts up the same money as bail for Hope who gets into and out of jail. In some not very clear manner it all ends with no money gained by Spade, but Hope telephones her love after leaving jail, and Effie is not sure that the whole affair will net her a new ribbon for her typewriter.

Appendix B

Judgment of the United States Court of Appeals, For the Ninth Circuit

CAPTION	No. 13,457

JUDGMENT

Appeal from the United States District Court for the Southern District of California, Central Division.

This cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On consideration whereof, It is now here ordered and adjudged by this Court, that the counterclaim of Dashiell Hammett be, and hereby is dismissed, and the Judgment running to him on it is reversed; otherwise, the Judgment of the said District Court in this cause be, and hereby is affirmed.

(ENDORSED) Judgment
Filed and entered November 9, 1954,
PAUL P. O'BRIEN, Clerk

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STATUTE

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IN THE

Supreme Court of the United States

October Term, 1954
No. 580

WARNER BROS. PICTURES, INC., a corporation, and ALFRED A. KNOPF, INC., a corporation,

Petitioners,

vs.

COLUMBIA BROADCASTING SYSTEM, INC., a corporation; WILLIAM SPIER; THE WILDROOT COMPANY, INC., a corporation; REGIS RADIO CORPORATION, WILLIAM ROBERT TALLMAN, GILES B. DOUD, JOE EISINGER, BATTEN, BARTON, DURSTINE & OSBORN, INC., and DASHIELL HAMMETT,

Respondents.

Answer of Respondents, Columbia Broadcasting System, Inc., a Corporation, William Spier, the Wildroot Company, Inc., a Corporation, Regis Radio Corporation, William Robert Tallman, Giles B. Doud, Joe Eisenger, and Batten, Barton, Durstine & Osborn, Inc., to Petition Warner Bros. Pictures, Inc., and Alfred A. Knopf, Inc., for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

Questions Presented.

1. Does the grant of specified limited rights, not expressly including character or sequel rights, in a copyrighted fictional detective story, prevent the author-grantor and his licensees from thereafter using the same characters in different stories subsequently written, in view of the long-standing and universal custom of detective fiction writers to continue the repeated use of their characters in succeeding stories?

copyrighted product. It is the converse. It is an effort by a grantee of limited rights in the copyrighted work to stop the author and his licensee from using the ungranted portions.

With respect to unfair competition, the title of the radio program was "The Adventures of Sam Spade," which was a part of the title of a book published in 1944, without objection of either Knopf or Warner, of other "Spade" stories written by Hammett after "The Maltese Falcon." Warner never used the name "Sam Spade" as, or as a part of, a title of any motion picture or radio program [R. 453]. Warner at no time made any contention that the broadcasts damaged the characters in any way or were not of fine quality. The Trial Court found, on ample evidence, that there was no palming off by defendants and that there was no public confusion between Warner's motion pictures and defendants' radio programs.

Although it may be quite irrelevant, we feel that the false impression created on page 4 of the Petition, that Columbia Broadcasting System was a proprietor in the radio program, should be corrected. Regis was the owner and producer [R. 454]; Columbia Broadcasting System, together with American Broadcasting Company and National Broadcasting Company [R. 454-455], simply furnished broadcasting facilities under contract, except in the one instance of its broadcast of one of "The Adventures of Sam Spade" scripts, "The Kandy Tooth," on its "Suspense" program.

REASONS FOR DENYING THE WRIT.

I.

The Decision Below Is Right Because Warner Obtained Only Limited Rights, Which Were Not Invaded by Regis' Radio Program.

Respecting the copyright infringement, the decision below is divisible into two parts: first, Warner obtained only limited rights, which were not infringed by defendants; and, second, the copyright alone does not protect character rights.

A. Warner Obtained Only Limited Rights.

Warner's rights arose from the contract of June 23, 1930 [R. 37]. It did not get unlimited rights "in the novel," that is, Hammett's entire creation, but only certain specified rights "in and to that certain story, hereinafter called 'writings,' entitled 'The Maltese Falcon.'" The contract enumerates in minute detail the portions acquired, and the absence of any specification of character or sequel rights is in sharp contrast to the detailed specification of the other rights. As components of the book, the contract expressly refers to the title, the theme, language, dialogue, scenes, and pictures. This is particularly pointed out in the Trial Court's Opinion [R. 79 and 81]. The very content of the contract itself exhibits a most assiduous effort and concern on the part of Warner to procure its rights to the ultimate. It is of utmost significance, therefore, that there is no mention of character or sequel rights.

Under these circumstances, the absence of any mention of character or sequel rights should be sufficient in itself to determine the case in appellees' favor. The most that can be said in aid of Warner's position is that there is an ambiguity, and the presence of this ambiguity invokes two legal propositions: strict construction against Warner, as author of the contract; and recourse to said custom and practice for proper construction.

B. There Is a Well-established Distinction Between Story and Characters in Detective Fiction.

The evidence abundantly shows (and it is so well-known as to be the proper subject for judicial notice [31 C. J. S. 651, Sec. 70]) that, at least from the time of Edgar Allen Poe in 1843, authors of detective fiction have used their same characters in successive and different stories, or "capers," as the word is used in this case. There is an obvious and major distinction between Sir Arthur Conan Doyle's rights in his first *story*, "A Study in Scarlet," which was a final, complete unit in itself, and in his great character, Sherlock Holmes, which he continued to use in so many later stories. The value of the character obviously greatly exceeded the value of any story in which he appeared.

Moreover, "The Maltese Falcon" is primarily a detective story and not a character development [R. 370]. Warner itself recognized this by abandoning entirely the name "Sam Spade" in its second picture based on "The Maltese Falcon," called "Satan Met a Lady," in which the name "Shane" was substituted [R. 274].

The suggested limitation, in the note at the bottom of page 9 of the Petition, of the custom of the continued

use by detective fiction writers of their characters in subsequent stories to the publication field because in its motion picture realm Warner obtained broader rights than the publisher, in that it obtained the story as "raw material" for its own creative purposes, is not well taken, because its use of the material was confined to Hammett's story (*Curwood v. Affiliated Distributors, Inc.*, 283 Fed. 219, 222 (S. D. N. Y., 1922), Knox, D. J.).

Indeed, if Warner's contention be sustained, then, contrary to all custom and usage, Sam Spade and his fellow characters will forever be confined to "The Maltese Falcon," because Warner cannot depart from that story.

Warner was bound by this custom prevailing in the mother field of literature to which it resorted continually for motion picture material, and in which it was a large and important dealer.

Krstovic v. Van Bueren, 235 N. Y. 96, 138 N. E. 749 (1923);

Walls v. Bailey, 49 N. Y. 464, 476 (1872);

Smith v. Clews, 114 N. Y. 190 (1889);

Ermolief v. R. K. O. Radio Pictures, 19 Cal. 2d 543, 552 (1942).

When the ambiguity in the contract of June 23, 1930, is resolved by recourse to said universal custom and practice in detective fiction writing, it is entirely clear that the contract did not convey to Warner character or sequel rights.

II.

The Character Rights Are Not Within the Protection of the Copyright Statute.

The suggestion of disastrous result (to the author, of course) envisioned on page 9 of the Petition, which allegedly would follow if the original characters were excluded from copyright protection, ignores the author's unfair competition remedy, akin to a trademark remedy. There is a distinction between the author's product and the identifying indicia of that product in the public's mind. These indicia, at least in the detective fiction field, are two-fold: title and characters. The consumer asks for an Arthur Conan Doyle detective story either by title of the particular story, if known, or by the name of the detective Holmes. Even the author's name is not a distinguishing feature because Doyle may have written poetry, which is quite outside the customer's desire. A cigarette smoker asks for a Lucky Strike because he desires to smoke a cigarette and he has learned to identify Lucky Strike with the gratification of his desire. He does not ask for an American Tobacco Company product because the producer's name might not be sufficiently definitive; it could include pipe or chewing tobacco, snuff, or even a different kind of cigarette.

Indeed, a tremendous public awareness of Sherlock Holmes and Dr. Watson has developed independently and apart from any one of the A. Conan Doyle stories [R. 336]. It has become a library practice to index detective characters separate from their stories [R. 341]. In 1930,

McGowan was preparing an anthology of great detectives, as distinct from the great detective stories in which they had appeared, during the period antedating the contract of June 23, 1930 [R. 342].

The title of a literary work is not protected by copyright.

Patten v. Superior Talking Pictures, Inc., 8 Fed. Supp. 196;

National Picture Theatres, Inc. v. Foundation Corp., 266 Fed. 208;

Paramore v. Mack Sennett, Inc., 9 F. 2d 66;

Becker v. Loew's, Inc., 133 F. 2d 891;

Detective Comics v. Bruns Publications, 111 F. 2d 432;

Nichols v. Universal Pictures Corp., 45 F. 2d 121.

It is protected, rather by the unfair competition remedy. The author may write successive stories under the same title, even as Warner produced two motion pictures under the same title, "The Maltese Falcon," the right to the use of which was expressly and separately mentioned in the contract.

In like manner, the characters are protectible by the unfair competition remedy.

Fisher v. Star Co., 231 N. Y. 414, 132 N. E. 133;

Johnston v. Twentieth Century-Fox Film Corp., 82 Cal. App. 2d 796;

Jackson v. Universal Pictures Co., 36 Cal. 2d 116.

This is the meaning or clear implication of the statement of the Court of Appeals that "the character is only the chessman in the game of telling the story," and, further, "the characters were the vehicles for the story told, and the vehicles did not go with the sale of the story." Hammett continued the use of Sam Spade in three succeeding stories, significantly without any objection from Knopf, the copyright owner. He could further have continued the use himself in any medium: printing, motion picture, radio, or television, but elected to do so through his licensees, who paid him for it, and whose payments, aggregating about $85,000, at $400 per week, in contrast to the $8,500 paid by Warner under the contract of June 23, 1930, were so much wasted money, if Petitioners' dire lament were well-founded. One would indeed be reckless if he undertook any use of Erle Stanley Gardner's "Perry Mason," without first dealing with Gardner, not because of copyright infringement but because of unfair competition and palming off an imitation on the unsuspecting public. Character rights are analogous to trademark rights, and the author may prevent their use by means of unfair competition remedy in the same manner as the use of titles.

As stated in *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, at 818, 187 P. 2d 474, at 487:

> "We should be realistic. It is common knowledge that since the advent of motion pictures—and particularly since the advent of radio—titles, names, slo-

gans, catch-phrases and the like have become of great value. Agreements for their use in particular fields are common. Large sums are paid for their use in advertising."

An author has such a continuing right in his characters, entirely apart from any copyright rights that he may prevent his own licensee from making any damaging or deteriorating or adulterating use of his characters. This shows a continuing right of the author in his characters separate and apart from any concept of copyright.

Prouty v. National Broadcasting Co., Inc., 26 Fed. Supp. 265.

Publication, instead of setting the characters adrift in the public domain, as argued at page 10 of the Petition, constitutes the factor which establishes their secondary meaning and either identifies them in the public mind with the author or identifies the story containing them as the desired literary product. Thus, publication becomes the *sine qua non* to the vesting in the author of the rights which are protectible by the unfair competition remedy.

The author therefore is not without adequate protection of his characters by means entirely independent of copyright, statutory or common law.

III.

There Is No Conflict Between the Ninth Circuit and the Second Circuit.

Judge Hand's comments in *Nichols v. Universal,* 45 F. 2d 121, were not even dicta; they were speculative reflections. It is submitted that if Judge Hand were confronted with this question, as it is presented by the facts of the case at bar, showing the radical difference between the copyrighted product, the detective story, and its market indicia, the title and characters, he would have been the first to refuse application of his speculation, particularly since the *Nichols* case involved a one-time single use of characters in another type of literary work, in contrast to the custom in the detective fiction field of continued use of the characters in subsequent cases.

The cases of *Detective Comics v. Bruns,* 111 F. 2d 432; *King Features Syndicate v. Fleischer,* 299 Fed. 533; *Fleischer v. Freundlich,* 73 F. 2d 276, and *Hill v. Whalen & Martell,* 220 Fed. 359, referred to under Point 3, beginning at page 11 of the Petition, are not in point because they involve pictures or cartoons which are the direct subjects of copyright protection, as well as textual matter and literary expressions accompanying the pictures and cartoons.

IV.

Warner Is Not Entitled to Any Recovery on the Theory of Unfair Competition.

A. The Essence of Unfair Competition Is Deception of the Public or Palming Off.

Sherwood v. Twentieth Century-Fox Film Corp., 18 N. Y. S. 2d 388, 390;

Atlas Mfg. Co. v. Street & Smith, 204 Fed. 398;

Becker v. Loew's, Inc., 133 F. 2d 891;

Lone Ranger, Inc. v. Cox, 124 F. 2d 650;

Fisher v. Star Co., 231 N. Y. 420.

B. There Is No Direct Evidence or Inference of Any Public Deception or Palming Off.

The evidence is exactly to the contrary. The trial court, construing the evidence, specifically held that there was no deception of the public or palming off [R. 91 and 110].

The important factor is the name, "Sam Spade," and Warner never used that name as a title or as any part of a title of any motion picture or radio or television program.

Warner publicized "The Maltese Falcon" and its star, Humphrey Bogart [R. 291]. In its second picture, "Satan Met a Lady," Warner even substituted a different name, Shane, for Spade. The testimony of Warner's witness, Irwin F. Dolid, showing extensive advertising of "The Maltese Falcon," does not include one word about advertising Sam Spade [R. 468-473].

This program became one of the top mystery programs on the air [R. 514]. It was defendants, not Warner, who

developed a public demand for a product under the name "Sam Spade" [R. 291]. Their billing of Spade is in marked contrast to Spade's anonymity in the motion pictures. Warner developed no secondary meaning in Sam Spade. Instead of the defendants' being guilty of unfair competition, it is Warner who, by this suit, is trying to reap where it has not sown by sitting quietly by for a year and a half while defendants built the name "Sam Spade" into a very valuable property, and then by coming into Court for the purpose of forcing the handing over of this asset.

Conclusion.

The basic and controlling proposition here is that, in detective fiction, the characters universally stand out and exist apart from any particular story and continue to appear in many stories and Warner's contract which conveyed to it only story rights, did not include the separate character rights. Hammett retained his character rights and validly conveyed them to Regis. The broadcasting therefore was legal and there is no basis for Petitioners' action.

Respectfully submitted,

JOE CRIDER, JR.,

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